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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,214	08/08/2001	Alexander Rollo Spewart	MURG/0004	2795
7590 06/04/2004			EXAMINER	
Gregory J. Lavorgna Esq. Drinker Biddle & Reath,LLP One Logan Square 18th & Cherry Streets Philadelphia, PA 19103-6996			TUCKER, PHILIP C	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

CF

**Office Action Summary**

Application No.

09/831,214

Applicant(s)

SPOWART, ALEXANDER ROLLO

Examiner

Philip C Tucker

Art Unit

1712

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 10-13 and 16-19 is/are rejected.
- 7) ☐ Claim(s) 4, 5, 7, 8, 12, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Ziolo et al (6048920).

Ziolo teaches a micronized polymeric product containing an oxide of iron, which is used in security printing (see abstract, column 7, lines 62-67 and column 9, lines 19-27).

3. Claims 1-3, 11, 13, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Voets (6114077).

Voets teaches a micronized toner composition which can be used in security printing, which comprises titanium oxide fused in a polymer, wherein the opacity (transmission) is utilized as an indicator toward visible light (column 5, lines 15-38 and Examples). No stimulated output is taught by such particles.

4. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Langley et al (3951672).

Langley teaches a glass which is fused and micronized which comprises a lead compound as in the present invention (see Example 1). No stimulated output is taught by such particles. Applicants intended use as a dopant in a security document does not distinguish (In re Pearson 181 USPQ 641).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6, 10, 12, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziolo (6048920).

Ziolo teaches a micronized polymeric product containing an oxide of iron, which is used in security printing (see abstract, column 7, lines 62-67 and column 9, lines 19-27). The formulation may be used in inks (column 6, lines 30-42 and column 7, lines 62-67). Ziolo differs from the present invention in that the specific use on a document is not disclosed. However, it would be obvious to one of ordinary skill in the art to utilize the micronized composite of Ziolo with documents, given the teaching of Ziolo that such is useful in security printing, and in ink formulations.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 refers to Table 5, which is improper except for extremely limited circumstances (see Ex parte Fressola 27 USPQ2d 1608). Claims should stand alone to define the invention.

***Claim Objections***

9. Claim 7 is objected to because of the following informalities: The brackets should be removed from claim 7, since it is not clear if the bracketed portion is a part of the claim. Appropriate correction is required.

10. Claims 4, 5, 8, 12, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Applicants arguments have been considered but are only deemed partially persuasive. The issue of public use or sale of the invention is removed, since there is not sufficient evidence to maintain such rejections. Applicants other arguments have been considered but are not deemed persuasive. Applicant has argued that the  $\text{TiO}_2$  of Voets is not a dopant because of the amount added. Applicants claims have no limitation on the amount of dopant that may be included in the document, and as such does not distinguish over Voets. Applicant has further argued that Voets does not teach the specific properties of the present invention. Applicant has given no reason why the oxide of titanium would behave differently in applicants invention, than in the Voets invention. In both instances, a micronized oxide of titanium in a carrier is used. It is well established in case law that a newly discovered property cannot distinguish over an old composition (In re Tomlinsin 150 USPQ 623). In claim 13, clearly the wavelength is shiftable by addition of other elements or by treatments.

With respect to Langley, security documents may not necessarily be handled directly, and may be covered to protect the documents. The amount used may be so small as to not have any toxic effect. Applicants claims teach several toxic substances such as lead etc., so it is not seen how such toxicity distinguishes over the prior art. A new rejection is presented over Ziolo.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Philip C Tucker  
Primary Examiner  
Art Unit 1712

PCT-3030